

Applicants : Mitchell Shirvan and Meir Bialer
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compounds of formula I and formula II (as recited in claim 1). The Examiner alleged that the claims as presented contain such vast multitude of possibilities and permutations for formula I and formula II compounds (as recited in claim 1) that the search for all allegedly places an undue burden on the office. The Examiner noted that the different species are classified in different subclasses: class 514, subclass 616, 613, 617, 274, and 211, for example. The Examiner indicated that due to the alleged structural diversity in formula I and formula II compounds encompassed by the claims and the alleged corresponding diversity in classification, the search for all species is an undue burden on the office. The Examiner noted that the search is not limited to patent files.

In reply, applicants elect with traverse N-(2-n-propylpentanoyl)glycinamide, encompassed by formula I recited in the claims. }

However, applicants contend that there would not be a serious burden on the Examiner if election were not required. Under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. A search of the prior art for methods of treating or preventing pain or headache disorders by the administration of a single disclosed derivative of valproic acid amide (formula I) would yield prior art regarding other disclosed derivatives of valproic acid employed for the same use. Similarly, since the compounds of formula I and the compounds of formula II differ only by the replacement of a single bond with a double bond, a search for compounds of formula I would also reveal compounds of formula II. Since the search and examination of the application can be made without serious burden, applicants

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respectfully request that the Examiner withdraw the election requirement.

Notwithstanding the foregoing, should the examination of the subject application begin with the elected species and the elected species be found allowable, applicants respectfully request examination of the generic claims pursuant to 37 C.F.R. § 1.146 and M.P.E.P. § 809.02, et seq.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Response. However, if any fee is deemed necessary, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Gary J. Gershik 9/27/02
John P. White Date
Reg. No. 28,678
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